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PATENT
Docket No.: 020375-002100US

TOWNSEND and TOWNSEND and CREW LLP

By: /Sandra Lee Bourassa, PLS/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

John Joseph Mascavage, III et al.

Application No.: 10/076,036

Filed: February 13, 2002

For: BUTTONS FOR PERSON TO
PERSON PAYMENTS

Customer No. 20350

Confirmation No. 7402

Examiner: Maguire, Lindsey M.

Technology Center/Art Unit: 3692

PETITION TO DIRECTOR OF
TECHNICAL CENTER 2100 UNDER 37
C.F.R. § 1.181

Via EFS-Web

MAIL STOP PETITION

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed on November 23, 2007 on the above-referenced application, Applicant respectfully submits this Petition to the Director of Technical Center 2100 under 37 C.F.R. §1.181

The *Requirement for Information* under 37 C.F.R. §1.105 was made in response to *Information Disclosure Statements* filed by the Applicants on May 23, 2005 and April 6, 2006 and requires "a concise statement of the relevance on all cited references who's [sic] dates are before 1950," stating "it is unclear how the references from 1874, 1873, 1908, etc. are relevant to the current application." However, the Applicants respectfully contend that the *Requirement for Information* is made without a reasonable basis for the information required, is overly broad, i.e., not clearly focused on the reason for the requirement, and improperly requires the Applicants to formulate and

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stipulate to opinions rather than facts. Therefore, the Applicants respectfully request withdrawal of the *Requirement for Information*.

Under 37 C.F.R. §1.105(a)(1):

"In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter."

As indicated in 37 C.F.R. §1.105(3):

"Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

- (i) A requirement for factual information;
- (ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or
- (iii) Stipulations as to facts with which the applicant may agree or disagree."

MPEP §704.11 further defines what information may be required:

"Information which may be required under 37 CFR 1.105 is that information reasonably necessary to properly examine or treat a matter in a pending or abandoned application filed under 35 U.S.C. 111 (including a reissue application), in a pending or abandoned application that has entered the national stage under 35 U.S.C. 371, in a patent, or in a reexamination proceeding.

There must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter. A requirement for information under 37 CFR 1.105 places a substantial burden on the applicant that is to be minimized by **clearly focusing the reason for the requirement and the scope of the expected response. Thus, the scope of the requirement should be narrowly defined, and a requirement under 37 CFR 1.105 may only be made when the examiner has a reasonable basis for requiring information.**

The terms 'factual' and 'facts' are included in 37 CFR 1.105 to make it clear that **it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant.**" (Emphasis added)

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The IDSs filed May 23, 2005 and April 6, 2006 were filed in a good faith effort to meet the requirements of 37 C.F.R. §1.56 in light of cases decided by the Court of Appeals for the Federal Circuit that have taken an expanded view of the information that must be disclosed by applicants. Thus, it is believed that the citation of the references dated prior to 1950 in the IDSs of May 23, 2005 and April 6, 2006 is appropriate in accordance with statements by the Fed. Cir. in McKesson Information Systems v. Bridge Medical, Inc., 487 F.3d 897, 913 (Fed. Cir. 2007).

However, the Applicants believe that requiring a concise statement of the relevance of each cited reference dated before 1950 is improper. As noted above, MPEP §704.11 requires that there be a reasonable basis for the information required. MPEP §704.11 provides:

"The criteria of reasonable necessity is generally met, e.g., where:
(A) the examiner's search and preliminary analysis demonstrates that the claimed subject matter cannot be adequately searched by class or keyword among patents and typical sources of non-patent literature, or
(B) either the application file or the lack of relevant prior art found in the examiner's search justifies asking the applicant if he or she has information that would be relevant to the patentability determination."

However, the Examiner did not indicate that the claimed subject matter cannot be adequately searched or provide any justification for the requirement based on a belief that the Applicants have information that would be relevant to the patentability determination. Rather, the Examiners only cite a few references already provided and the burden of considering these references.

Also as noted above, MPEP §704.11 limits the information that can be required to facts and prohibits requirements for opinions. The Applicants respectfully submit that this requirement essentially requires the Applicants to evaluate prior art references and to engage in an examination of the present claims. Thus, the Applicants are being required to formulate and stipulate to opinions rather than facts. For at least these reasons, the requirement is improper and should be withdrawn.

Thus, the Applicants respectfully submit that the requirements made in the *Requirement for Information* are made without a reasonable basis for the information

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required, are overly broad, i.e., not clearly focused on the reason for the requirement, and improperly require the Applicants to formulate and stipulate to opinions rather than facts. For at least these reasons, the Applicants believe the Requirement for Information is improper. Therefore, the Applicants request withdrawal of the *Requirement for Information*.

CONCLUSION

Applicant believes that no fees are due for this Petition. However, the Commissioner is authorized to deduct any Fees for this Petition from the undersigned's Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

If the Director believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at: 303-571-4000.

Respectfully submitted,



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